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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,805	08/30/2001	Serge Restle	05725.0927	6749

22852 7590 10/07/2003

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/07/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,805

Applicant(s)

RESTLE ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-76 is/are pending in the application.
- 4a) Of the above claim(s) 25-33, 38-48, 50-73, and 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 34-37, 49, 74 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 9, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of group I, claims 24, 34-37, 49-74, and 75 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that allegedly no burden on examiner is shown. This is not found persuasive because examiner had clearly indicated in the Election Requirement dated March 21, 2003 on p. 3, second paragraph that, given the number of diverse groups of esters applicants presented as both Markush group and dependent claims, examining entire groups would impose serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 25-33, 38-48, and 76 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 34-37, 49-74, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 6113890).

Young teaches a shampoo composition comprising ammonium laureth sulfate and sodium lauryl sarcosinate an anionic surfactant and amphoteric surfactant, respectively, and an organic oil in an aqueous carrier. See Examples IV and IX. The reference also teaches the method of using the composition. See col. 13, lines 20 – 60l; instant claims 74 and 75. The reference teaches using organic oil in the shampoo composition. While Examples IV and IX employ Permethyl 102A, an isoparaffin, the reference also teaches using fatty esters such as hexyl laurate, lauryl lactate, and cetyl lactate. See col. 10, lines 21 – 43.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the disclosed formulations in Young by substituting the organic oils used therein with the fatty acids as motivated by the reference because of the expectation of successfully producing a shampoo composition with similar effects.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24, 34-37, 49, 74, and 75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 20-22, 26, and 27 of U.S. Patent No. 6432908 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims claim a detergent composition comprising at least one carboxylic ester, surfactants, and a cosmetically acceptable carrier. See '908 patent, claim 1. Claim 7 recites anionic and amphoteric surfactants. Claims 21-22 recite monoesters of monoalcohols such as ethyl and isopropyl palmitates, hexyl stearate, butyl stearate, butyl myristate, isopropyl myristate. See instant claim 49. Claims 26 and 27 of '908 patent recite method of using the composition. See instant claim 74 and 75. The term "a cosmetically acceptable medium" in claim 2 of the '908 patent means water, according to Example 1 in the specification.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of '908 patent by adding the washing base and the specific carboxylic esters in an aqueous medium, as motivated by the claimed invention in the patent, because of the expectation of successfully producing a deterative composition for cleaning and conditioning hair.

Conclusion

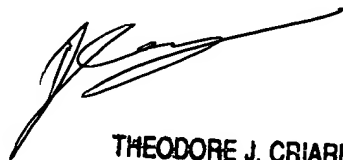
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner



THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200/600